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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,758	10/15/2003	George K. Phillips	VFT-014	8706
23410	7590	12/11/2007		
Vista IP Law Group LLP 2040 MAIN STREET, 9TH FLOOR IRVINE, CA 92614			EXAMINER FERGUSON, LAWRENCE D	
			ART UNIT	PAPER NUMBER
			1794	
			MAIL DATE	DELIVERY MODE
			12/11/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/686,758	Applicant(s) PHILLIPS ET AL.	
	Examiner Lawrence D. Ferguson	Art Unit 1794	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 November 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: 1,3,4,6,9-11,14-20,22,23,25,28,29 and 32-49.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant argues Phillips does not disclose that bearer information that is overprinted on the original document is rendered unreadable on a copy of the document. Examiner maintains it is inherent that the hidden message (bearer information) of Phillips would be unreadable on a document copy. The latent image (14) would be unreadable on a document copy as a result of the image (14) only being visible when viewed at a certain angle. If the image can be only be viewed at a certain angle and most copiers do not copy at an angle, the image would not appear on a copy as it would appear at the viewing angles of 20° to 70°. Applicant stated it was concluded that the latent image 14 that is formed by the image structure 18 on the overlay marker 10 in Phillips is the bearer information. Examiner concluded the latent image 14 is the bearer information that is formed on the surface of the overlay marker 10 and the diffusing markings 16, as the height of the markings is for illustrative purposes only (column 4, lines 30-38 and 45-56). Applicant argues the latent image cannot be overprinted on the image structure and raised markings since the latent message is formed by the contrast between the image structure and raised markings (column 4, lines 40-45). Examiner respectfully disagrees with this argument as column 4, lines 40-45 does not disclose the latent image is formed by the contrast between the image structure and raised markings. Applicant argues it has not been shown show the document of Phillips would necessarily be unreadable on a copy of the document. Examiner maintains that the latent image (14) would be unreadable on a document copy as a result of the image (14) only being visible when viewed at a certain angle. If the image can be only be viewed at a certain angle and most copiers do not copy at an angle, the image would not appear on a copy as it would appear at the viewing angles of 20° to 70°. Applicant further argues the human eye/brain operate in a different manner than copy machines as the reflectance exhibited by the original document would turn the latent image black on a document copy at any angle as it blends with the camouflaging background pattern. Considering Applicant's argument, it is a reasonable assertion to conclude that the latent image could turn black and mix with the camouflaging background pattern, which would still render the latent image unreadable on a document copy, as claimed by Applicant. Applicant argues it has not been shown where the relief markings are non-black and/or white. Figure 5 shows the relief markings 16 as white and shows the raised markings as a plurality of nano-characters (the rectilinear structure forming the diffusing layer). Regarding claims 39,42,45, and 48 it is maintained that the phrase, "for allowing the bearer information to be readable on an original document" constitutes a 'capable of' limitation and that such a recitation that an element is 'capable of' performing a function is not a positive limitation but only requires the ability to so perform. Applicant argues Scampini in a 103 rejection; however, claims 6,14,25 and 32 were not rejected under a Scampini reference.



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